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DIVISION

06/7/7042
23M8
23410-1395
183-540.00 #32

PATENT
Attorney Docket No. 16842

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent of:
HAGENBUCH
No. 4,839,835
Issued: June 13, 1989
For: APPARATUS AND METHOD
RESPONSIVE TO THE ON-
BOARD MEASURING OF
THE LOAD CARRIED BY A
TRUCK BODY

RECEIVED
FEB 8 1996
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Attn: Maintenance
Fee Division
Box M Fee

NOTIFICATION PURSUANT TO 37 C.F.R. §§ 1.28(b) AND (c) OF
LOSS OF ENTITLEMENT OF SMALL ENTITY STATUS AND ERROR
IN PAYMENT OF FEE AS A SMALL ENTITY

Assistant Commissioner
for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.28(b), the Patent Owner hereby notifies the Patent and Trademark Office that the above-identified patent is no longer entitled to status as a small entity and that the claim for small entity status set forth in the verified statement filed with the application for that patent is hereby withdrawn.

On April 1, 1985, verified small entity statements for an independent inventor and a small business were filed with the application for U.S. Patent No. 4,839,835, which issued on June 13, 1989 (hereinafter "the '835 patent"). The statements correctly established the application as entitled to small entity status. The first maintenance fee for the '835 patent was paid pursuant to small entity status on or about December 13, 1992.

Before the payment of the first maintenance fee, but after payment of the issue fee, a change occurred whereby small entity status could no longer be claimed by the '835

In re HAGENBUCH
U.S. Patent No. 4,839,835

PATENT & TRADEMARK
OFFICE

JAN 23 96

patent. Through good-faith error, however, the Patent and Trademark Office was not notified.

Because the date of this notification is more than three (3) months after the '835 patent lost its small entity status, the following is a statement pursuant to 37 C.F.R. § 1.28(c) explaining how the error in payment of the above-identified fee occurred in good faith and how and when it was discovered.

**Calculation and Payment of Deficiency Pursuant
to 37 C.F.R. § 1.28(c)**

Payment is attached for the sum of \$540.00 for the deficiency between the amount of fee paid (i.e., \$450.00) and the amount of \$990.00 due for a large entity, according to the October 1, 1995 fee schedule in effect as of the date of this notification as required by 37 C.F.R. § 1.28(c).

Statement Pursuant to 37 C.F.R. § 1.28(c)

On April 1, 1985, two verified small entity statements (one for a "small business," the other for an "independent inventor") were filed in U.S. patent application Serial No. 06/717,042, which matured into the '835 patent. At the time these statements were filed and when the '835 patent issued on June 13, 1989, the '835 patent was entitled to the small entity status. More than two years after the '835 patent was issued, however, the Patent Owner LeRoy G. Hagenbuch (hereinafter "the Patent Owner") entered into an agreement granting Caterpillar, Inc. of Peoria, Illinois, a non-exclusive license to the '835 patent and co-owned U.S. Patent No. 4,831,539 (hereinafter "the '539 patent"). Caterpillar, Inc. is not entitled to small entity status. An error occurred in good faith when the Patent Owner failed to withdraw the small entity status of the '835 patent after the license to Caterpillar was executed.

In re HAGENBUCH
U.S. Patent No. 4,839,835

PATENT & TRADEMARK
OFFICE

JAN 23 96

The dates for payment of the first, second, and third maintenance fees for the '835 patent are monitored by a docketing department at Leydig, Voit & Mayer, which is the firm that prepared and prosecuted the patent application for the '835 patent. A docketing entry was made when the '835 patent was issued in order to provide a reminder of the due dates for payment of the maintenance fees.

The docketing department monitors the maintenance fee dates for a large number of U.S. patents which are contained in a database along with the maintenance fee dates of the '835 patent. As a due date for payment of a maintenance fee approaches, the docketing department prepares and sends a letter to the patent owner requesting instructions for payment of the maintenance fee. Attached as Exhibit A is a copy of a letter to the Patent Owner from the docketing department of Leydig, Voit & Mayer requesting instructions regarding the payment of the first maintenance fee.

1. How The Error Occurred In Good Faith

In the letter of Exhibit A, the docketing department of Leydig, Voit & Mayer asked the Patent Owner to inform it of a change in the small entity status of the '835 patent and refers the Patent Owner to an attached copy of a definition of a "small business concern" taken from the Code of Federal Regulations. In this regard, attached as Exhibit B is a declaration by the Patent Owner stating he was unaware that the licensing agreement affected the entitlement of the '835 patent to the payment of maintenance fees according to the small entity schedule. The Patent Owner did not become aware of the possible effect of the license agreement with Caterpillar until he was informed of it by the undersigned in September of 1995.

Although the undersigned is the attorney at Leydig, Voit & Mayer responsible for the prosecution of the '835 patent, he did not receive a copy of the letter of Exhibit A

In re HAGENBUCH
U.S. Patent No. 4,839,835

PATENT & TRADEMARK
OFFICE

JAN 23 96

at the time it was mailed. Instead, in accordance with standard procedure at Leydig, Voit & Mayer, the letter of Exhibit A was sent directly from the docketing department to the Patent Owner. Thus, the undersigned was unaware the maintenance fee for the '835 patent was paid pursuant to a small entity status until the error was discovered as described below.

2. How And When The Error Was Discovered

The first awareness of an issue regarding whether the '835 patent was properly entitled to maintain its small entity status resulted from a consideration of a licensing strategy for the U.S. Patent No. 5,416,706 (hereinafter "the '706 patent"), which issued from a continuation-in-part of the '835 or '539 patents (see the chronology of related patents in Exhibit C). In considering an appropriate strategy for initiating a licensing program of the '706 patent, the undersigned met with the Patent Owner, on August 14, 1995. During this meeting, the Caterpillar licensing agreement was discussed, including the language granting a license to patents based on continuations or continuations-in-part of the '835 or '539 patents. ✓

After that meeting and in the process of preparing information disclosure statements and amendments for several of the pending patent applications in Exhibit C, the undersigned realized that a small entity status that was correct when established had been carried forward into all of the Rule 60 and Rule 62 continuations of Exhibit C and have been in error in view of the apparent scope of the license agreements. It was only then that the undersigned checked the docketing records at Leydig, Voit & Mayer to determine whether the maintenance fee had been paid for the '835 and '539 patents pursuant to large or small entity status. Those records have now been corrected to identify the large entity fee for future payments.

In re HAGENBUCH
U.S. Patent No. 4,839,835

PATENT & TRADEMARK
OFFICE

JAN 23 96

Conclusion

PATENT MAINTENANCE
DIVISION

For the '835 and '539 patents and the Rule 60 and 62 continuations-in-part of them identified in the chronology of Exhibit C, all Patent Office fees paid after the execution date of the Caterpillar licensing agreement (i.e., October 25, 1991) should have been paid in the amount for a large entity. For each of these patents and patent applications in which fees were paid after the date of the Caterpillar agreement, Patent Owner is contemporaneously paying the deficiency between the amount paid and the amount due for a large entity and is also filing into the application the appropriate documents pursuant to 37 C.F.R. § 1.28.

Signed at Chicago, County of Cook and State of Illinois, on January 22nd, 1996.

Respectfully submitted,

By John B. Conklin
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